

REMARKS

Claims 1-19 are pending in the subject application. Claims 1-13 and 19 were withdrawn subject to a restriction requirement and claims 14-18 were rejected. Applicant has not amended, added or deleted any claims. Accordingly, claims 14-18 are presently being examined.

In view of the following Response, applicant respectfully requests that the Examiner reconsider and withdraw the rejections made in the outstanding Office Action.

Rejection of Claims 14-18 under 35 U.S.C. Section 103(a) as Being Unpatentable over *Wilson et al.*

The Examiner has rejected claims 14-18 under 35 U.S.C. Section 103(a) as being unpatentable over United States patent no. 3,863,013 (*Wilson et al.*). The Examiner states that *Wilson et al.* discloses five or six membered heterocyclic compounds employed to alter the flavor or aroma of a foodstuff or perfumed article. The Examiner argues that *Wilson et al.* (column 6) discloses that other flavoring or perfume adjuvants may also be employed and specifically discloses mercapto-substituted compounds. The Examiner contends that *Wilson et al.* discloses each and every aspect of the invention as claimed by the applicant with the exception of the specific mercapto-substituted compound claimed by the applicant, more specifically ethyl 3-mercaptopropionate. The Examiner concludes that it would have been obvious to have substituted the mercapto compounds of *Wilson et al.* with the specific compounds claimed by applicant with only a minimum of experimentation guided by *Wilson et al.* that such compounds are known in this art.

as perfume additives or flavoring compounds. The Examiner argues that the limited number of possible permutations in the series of lower alkyl esters of 3-sulfur substituted straight chain C4 and C6 alkanoic acids could be achieved through routine experimentation with a reasonable expectation of success. The Examiner concludes that one of ordinary skill would have been motivated by the teaching of *Wilson et al.* to have arrived at applicant's invention. Applicant traverses the Examiner's rejections.

Applicant's invention (claim 14) provides a method to confer, enhance, improve, or modify the odor properties of a perfuming composition or a perfumed article, which comprises adding to the perfuming composition or perfumed article, ethyl 3-mercaptopropionate represented by the formula, $\text{CH}_3(\text{SH})\text{CHCH}_2\text{COOCH}_2\text{CH}_3$. Preferably, ethyl 3-mercaptopropionate is present in the perfuming composition or perfumed article in an amount from about 0.001% to about 1%, by weight, more preferably in an amount from about 0.1% to about 0.50%, by weight.

Applicant's invention (claim 17) provides a perfuming composition or a perfumed article containing as an active perfuming ingredient, ethyl 3-mercaptopropionate represented by the formula, $\text{CH}_3(\text{SH})\text{CHCH}_2\text{COOCH}_2\text{CH}_3$. The perfumed article may be in the form of a perfume or a cologne, a soap, a bath or shower gel, a shampoo or other hair care product, a body deodorant, an air freshener, a detergent or fabric softener, or a household cleaner.

The *Wilson et al.* reference discloses a five or six membered **HETEROCLIC** compound having **TWO** sulfur atoms, such as a dithiolane or a dithiane, to alter the flavor or aroma of a consumable material such as a foodstuff or perfume. (see Abstract and col. 14, lines 7-35).

Contrary to the Examiner's position, applicant submits that *Wilson et al.* does not teach or suggest applicant's perfuming composition containing as an active perfuming ingredient, ethyl 3-mercaptopropionate represented by the formula, $\text{CH}_3(\text{SH})\text{CHCH}_2\text{COOCH}_2\text{CH}_3$. Rather, *Wilson et al.* teaches the use of a five or six membered **HETERO CYCLIC** compound having **TWO** sulfur atoms, such as a dithiolane or a dithiane. *Wilson et al.* does not teach applicant's **NON-CYCLIC** flavoring agent having **ONE** sulfur atom, ethyl 3-mercaptopropionate.

Applicant submits that alteration of the volatility and/or polarity of a compound, such as changing the number, or character, of carbon atoms and/or the number or polarity of mercapto groups, can greatly affect the flavoring properties of that compound. The flavor of a compound is the combination of nerve impulses on brain centers as the result of interactions of the flavor compound and receptors located on the tongue and in the lining of the nose. No reliable correlation of taste with chemical structure has yet been established.

Applicant has stated the following in the specification.

The GeneressenceTM flavor research program conducted by Bush Boake Allen focuses on developing flavors by employing in depth understanding of the volatile organic components present in a wide variety of samples, for example fruits and herbs and coupling this information to flavor preference profiling. A number of sampling and analytical techniques are used including extraction and headspace analyses often including the sampling of growing fruit or flowers. The flavors are primarily formulated from synthetic chemicals and contain only components identified in the sample. There is no limit to the concentration of individual components used apart from organoleptic considerations. A problem with developing flavoring agents for fruity and herbaceous materials, such as mango flavor, is that natural plant materials do not contain a single flavoring agent,

but rather contain a complex mixture of volatile components making identification of characteristic flavors very difficult. The volatiles of mango were analyzed by gas chromatography and a combined gas chromatograph-mass spectrometer. The volatiles were also analyzed by gas chromatography on a sulfur detector. (applicant's specification at page 2, lines 13-27)

Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference. *Continental Can*, 948 F.2d at 1268-69, 20 USPQ 2d at 1749-50. The test of inherency is not satisfied by what a reference "may" teach. Id., 20 USPQ 2d at 1749-50 ("Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.") (emphasis added). *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp.*, 32 USPQ 2d 1496, 1503 (Fed. Cir.) (unpublished), cert. denied' 115 S. Ct. 655 (1994).

The Examiner cites no reference teaching or suggesting the use of method to enhance the odor properties of a perfuming composition, which comprises adding to the perfuming composition, ethyl 3-mercaptopropionate represented by the formula, $\text{CH}_3(\text{SH})\text{CHCH}_2\text{COOCH}_2\text{CH}_3$. In the absence of such teachings by the cited reference, the Examiner cannot assert that it would have been obvious to provide ethyl 3-mercaptopropionate.

[A]s a matter of law under 35 U.S.C. Section 103, the examiner must substantiate his "suspicions" on the basis of facts drawn from proper prior art. The issue to be resolved requires more than "suspicions;" it requires facts.... The provisions of section 103 must be followed realistically to develop the factual background against which the section 103 determination must be made. All of the facts must be considered.... *In re Lunsford*, 357 F.2d 380, 391, 148 U.S.P.Q. 716, 725 (C.C.P.A. 1966) [emphasis in original].

The provisions of Section 103 must be followed realistically to develop the factual background against which the Section 103 determination must be made. It is not proper within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The references of record fail to teach or suggest applicant's invention as a whole.

Accordingly, the Examiner's rejection of claims 14-18 under 35 U.S.C. Section 103(a) as being unpatentable over *Wilson et al.* should be withdrawn.

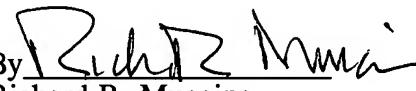
Obviousness of a composition or process must be predicated on something more than it would be obvious "to try" the particular component recited in the claims or the possibility it will be considered in the future, having been neglected in the past. *Ex parte Argabright et al.* (POBA 1967) 161 U.S.P.Q. 703. There is usually an element of "obvious to try" in any research endeavor, since such research is not undertaken with complete blindness but with some semblance of a chance of success. "Obvious to try" is not a valid test of patentability. *In re Mercier* (CCPA 1975) 515 F2d 1161, 185 U.S.P.Q. 774; *Hybritech Inc. v. Monoclonal Antibodies. Inc.* (CAFC 1986) 802 F2d 1367, 231 U.S.P.Q. 81; *Ex parte Old* (BPAI 1985) 229 U.S.P.Q. 196; *In re Geiger* (CAFC 1987) 815 F2d 686, 2 U.S.P.Q.2d 1276. *In re Dow Chemical Co.* (CAFC 1988) F2d, 5 U.S.P.Q.2d 1529. Patentability determinations based on that as a test are contrary to statute. *In re Antonie* (CCPA 1977) 559 F2d 618, 195 U.S.P.Q. 6; *In re Goodwin et al.* (CCPA 1978) 576 F2d 375, 198 U.S.P.Q. 1; *In re Tomlinson et al.* (CCPA 1966) 363 F2d 928, 150 U.S.P.Q. 623. A rejection based on the opinion of the Examiner that it would be "obvious to try the chemical used in the claimed

process which imparted novelty to the process does not meet the requirement of the statute (35 U.S.C. 103) that the issue of obviousness be based on the subject matter as a whole. *In re Dien* (CCPA 1967) 371 F2d 886, 152 U.S.P.Q. 550; *In re Wiaains* (CCPA 1968) 397 F2d 356, 158 U.S.P.Q. 199; *In re Yates* (CCPA 1981) 663 F2d 1054, 211 U.S.P.Q. 1149. Arguing that mere routine experimentation was involved overlooks the second sentence of 35 USC 103. *In re Saether* (CCPA 1974) 492 F2d 849, 181 U.S.P.Q. 36. The issue is whether the experimentation is within the teachings of the prior art. *In re Waymouth et al.* (CCPA 1974) 499 F2d 1273, 182 U.S.P.Q. 290. The fact that the prior art does not lead one skilled in the art to expect the process used to produce the claimed product would fail does not establish obviousness. *In re Dow Chem. Co.* (CAFC 1988) 5 U.S.P.Q.2d 1529.

In view of the foregoing Response, applicants request reconsideration pursuant to 37 C.F.R. Section 112 and allowance of the claims pending in this application. Applicant requests the Examiner to telephone the undersigned attorney should the Examiner have any questions or comments which might be most expeditiously handled by a telephone conference. No fee is deemed necessary in connection with the filing of this Response. If any fee is required, however, authorization is hereby given to charge the amount of such fee to Deposit Account No. 13-4822.

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Applicant's attorney authorizes the Examiner to charge Deposit Account 13-4822 if there are any additional charges in connection with this matter.

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